

PRE-APPEAL BRIEF REQUEST FOR REVIEW

(filed with the Notice of Appeal)

Application Number: 09/750,144	Filed December 29, 2000
First Named Inventor: Steven Lewontin	
Art Unit: 2176	Examiner: Paul H. Nguyen BA

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

Attachment: Remarks (five (5) pages)

Respectfully submitted,

Andrew T. Spence
Registration No. 45,699

Date 4/11/06

Customer No. 00826
ALSTON & BIRD LLP
Bank of America Plaza
101 South Tryon Street, Suite 4000
Charlotte, NC 28280-4000
Tel Charlotte Office (704) 444-1000
Fax Charlotte Office (704) 444-1111

CERTIFICATION OF FACSIMILE TRANSMISSION

I hereby certify that this paper is being facsimile transmitted to the US Patent and Trademark Office at
Fax No. 571 273-8300 on the date shown below.

Sarah B. Simmons
Sarah B. Simmons

April 11, 2006
Date

In re: Steve Lewontin
Appl. No.: 09/750,144
Filed: December 29, 2000

REMARKS

This communication is filed in response to the final Official Action of October 14, 2005, and the Advisory Action of March 8, 2006. The final Official Action and Advisory Action continue to reject Claims 1-3, 5, 7, 10-13, 15, 17, 20 and 21 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent Application Publication No. 2004/0049737 to Simon Hunt et al., in view of U.S. Patent No. 6,003,033 to Amano et al. The final Official Action and Advisory Action also continue to reject Claims 4, 6, 8, 9, 14, 16, 18 and 19 under 35 U.S.C. § 103(a) as being unpatentable over the Simon Hunt publication in view of the Amano patent, and further in view of U.S. Patent Application Publication No. 2002/0143521 to Call. As explained in response to the final Official Action and below, Applicant respectfully submits that the claimed invention is patentably distinct from the Simon Hunt publication, Amano patent and Call publication, taken individually or in combination. In view of the remarks presented herein, Applicant respectfully requests reconsideration and reversal of the rejections to the claims.

Again, as background, the present patent application is directed to a compact tree representation of a document written in a markup language (e.g., XML). More particularly, independent Claim 1 provides a method of representing a document written in a markup language on a mobile terminal, and independent Claim 10 provides a mobile phone including software components for carrying out such a method. As recited, the method includes providing a virtual node tree describing the structure of the data types in the document but not containing actual document data, where each of the nodes in the virtual node tree respectively correspond to one element of a specific data type in the document. The method also includes providing a data array for each one of the nodes in the virtual node tree, where the data array includes information identifying the relationship of the node to other nodes in the virtual node tree and a reference indicating the location of data corresponding to the node. Thus, the data corresponding to the nodes using the reference included in the data array can be obtained by a set of software components in the mobile terminal.

The final Official Action alleges, and the Advisory Action maintains, that the Simon Hunt publication discloses all of the elements of independent Claims 1 and 10 including providing a virtual node tree and obtaining data corresponding to the nodes of the tree, but does not disclose a virtual node tree not containing actual document data. For that element, the final

Appl. No.: 09/750,144
Amdt. dated 04/11/2006
Reply to Official Action of October 14, 2005

Official Action cites the Amano patent. The final Official Action then alleges it would be obvious to one skilled in the art to modify the teachings of the Simon Hunt publication with those of the Amano patent to include a virtual node tree that does not include actual document data.

A. Simon Hunt Cited Disclosure is not Prior Art to the Claimed Invention

As to the Simon Hunt publication, Applicant notes that the disclosure relied upon by the Official Action for disclosing elements of the claimed invention is not prior art to the present application, and can therefore not be properly cited against the claimed invention. Again, the Simon Hunt publication has a filing date of October 25, 2002 and claims priority as a continuation-in-part of two utility patent applications both filed April 25, 2001, as well as a provisional patent application filed April 26, 2000. The present application, on the other hand, has a filing date of December 29, 2000. The present application therefore has an effective filing date before the filing date of the Simon Hunt publication on October 25, 2002, and the two utility patent applications on April 25, 2001. Accordingly, the Simon Hunt publication is only prior art for the subject matter that was first disclosed by the Simon Hunt provisional application. By way of example, the content of the Simon Hunt provisional application that is carried over into the Simon Hunt publication may be considered prior art. Subject matter that is newly added in the Simon Hunt publication or utility applications that was not disclosed by the Simon Hunt provisional application is not prior art relative to the present application.

In order to determine the relevance of the Simon Hunt publication to the claimed invention, Applicant's undersigned attorney has obtained and reviewed a copy of the Simon Hunt provisional application from the USPTO's public PAIR Web portal. The final Official Action cited portions (e.g., paragraphs 0146-0151) of the Simon Hunt publication directed to a QDOM module generating a representation of a document object model (DOM) tree of a document into an array that includes the start and stop position of the document text as corresponding to the claimed feature of providing a virtual node tree. The Simon Hunt provisional application, however, is silent as to the QDOM or its technique for generating a representation of a DOM tree. The Simon Hunt publication does disclose normalizing a DOM

Appl. No.: 09/750,144
Amdt. dated 04/11/2006
Reply to Official Action of October 14, 2005

tree, but the disclosed normalization does not realize a data array including information identifying the relationship of a node to other nodes in the virtual node tree and a reference indicating the location of data corresponding to the node, as in the claimed invention. Thus, at least those portions of the Simon Hunt publication that were relied upon by the Official Action are not prior art relative to the claimed invention.

In response to the foregoing, the Advisory Action asserts that QDOM is the term for application of a DOM tree that identifies each node in a document using a unique value. The Advisory Action continues by asserting that the provisional application discloses a DOM tree being subjected to a normalization process. Applicant respectfully submits, however, that in attempting to support the passages of the Simon Hunt publication cited for disclosing aspects of the claimed invention, the Advisory Action has not cited any corresponding passages of the Simon Hunt provisional application. That is, although the final Official Action cites passages of the Simon Hunt publication directed to the QDOM and its operation, the Advisory Action has not cited any corresponding portion of the Simon Hunt provisional application, but has instead cited passages of the Simon Hunt provisional application directed to the normalizer of the Simon Hunt publication.

Applicant respectfully submits that, although the Simon Hunt provisional application discloses subjecting a DOM tree to a normalization process, such a process is separate and distinct from the QDOM disclosed by the Simon Hunt publication, and cited by the Examiner as disclosing aspects of the claimed invention. More particularly, the Simon Hunt publication discloses a QDOM 116 that converts data content into a document object tree. The QDOM and its technique for generating a representation of a DOM tree are illustrated at FIGS. 8 and 9, and the accompanying disclosure including paragraphs 0146-0157 (including the passages cited by the Examiner, paragraphs 0146-0151). Separate and distinct from the QDOM 116, the Simon Hunt publication also discloses a normalizer 124 that analyzes a DOM tree and generates a normalized tree. The normalizer and its technique for generating a normalized tree are illustrated at FIGS. 10 and 11, and the accompanying disclosure including paragraphs 0158-233. Applicant respectfully submits that only portions of the normalizer and its technique for generating a normalized tree are disclosed by the Simon Hunt publication.

Appl. No.: 09/750,144
Arndt. dated 04/11/2006
Reply to Official Action of October 14, 2005

Applicant therefore respectfully submits that the Simon Hunt provisional application only supports portions of the Simon Hunt publication directed to a normalizer. And nowhere does the Simon Hunt provisional application teach or suggest that the normalizer realizes a data array including information identifying the relationship of a node to other nodes in the virtual node tree and a reference indicating the location of data corresponding to the node, as in the claimed invention.

B. *No Motivation to Combine Simon Hunt and Amano*

Moreover, Applicant notes that even if one could interpret (albeit incorrectly) the Simon Hunt publication to disclose elements of the claimed invention to also be prior art to the claimed invention as alleged in the final Official Action, one skilled in the art would not have been motivated to combine the teachings of the Simon Hunt publication and Amano patent to teach or suggest the claimed invention. The final Official Action appears to be applying impermissible hindsight in finding motivation to combine the various cited references to disclose the claimed invention. *See In Re Dembiczaik*, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999) (explaining that “[c]ombining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the inventor’s disclosure of a blueprint for piecing together the prior art to defeat patentability -- the essence of hindsight”).

As stated in MPEP § 2143.01, “the mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination.” MPEP § 2143.01 (citing *In re Mills*, 916 F.2d 680 (Fed. Cir. 1990)) (emphasis added). In addition, as has been held by the Board of Patent Appeals and Interferences, and noted in the MPEP, the mere fact that one skilled in the art could adapt the reference device to meet the terms of a claim is not by itself sufficient to support a finding of obviousness. The prior art or the general knowledge of one skilled in the art must also provide a motivation or reason for one skilled in the art, without the benefit of applicant’s specification, to make the necessary modifications to the reference device. MPEP 2144.04(VI.)(C.) (citing *Ex parte Chicago Rawhide Mfg. Co.*, 223 USPQ 351, 353 (Bd. Pat. App. & Inter. 1984)). Thus, Applicant respectfully submits that merely asserting that modifying the Simon Hunt publication

Appl. No.: 09/750,144
Amdt. dated 04/11/2006
Reply to Official Action of October 14, 2005

with the Amano patent provides for easily describing a tree, and generating a data structure that corresponds to the tree in memory with the resultant description, without explaining the motivation or suggestion for such a combination (without relying upon hindsight or otherwise being guided by the present application), does not by itself render obvious the claimed invention.

Applicant further respectfully submits that the Call publication does not cure the defects of the Simon Hunt publication and Amano patent, and that independent Claims 1 and 10, and by dependency Claims 2-9 and 11-21, are therefore patentable distinct from the Simon Hunt publication, Amano patent and Call publication, taken individually or in combination. Accordingly, Applicant also respectfully submits that the rejections of Claims 1-21 as being unpatentable over various combinations of the Simon Hunt publication, Amano patent and Call publication should be reversed.